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SUTHERLAND II			EXAMINER	
SUTHERLAND, ASBILL & BRENNAN, LLC			CAMPEN, KELLY SCAGGS	
999 PEACHTREE STREET				
ATLANTA, GA 30309			ART UNIT	PAPER NUMBER
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			03/17/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/025,897

**Applicant(s)**

KIGHT ET AL.

**Examiner**

KELLY CAMPEN

**Art Unit**

3691

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 March 2008 and 10 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 76-96 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 76-96 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 December 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

In consideration of the interview held on 10/23/2008, the prior Non Final Office Action dated 6/10/2008 has been vacated and new Non Final Office Action is presented herewith.

*The following is in response to the remarks and amendments filed 3/13/2008. Claims 76-96 are pending.*

#### ***Election/Restrictions***

The Restriction Requirement of has been withdrawn in view of the newly filed claims and canceled pending/originally filed claims.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 76-85 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 76-85 recite a process comprising the steps of receiving, selecting and directing.

Based on Supreme Court precedent, a proper process must be tied to another statutory class or transform underlying subject matter to a different state or thing (*Diamond v.*

*Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978);

*Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88

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(1876)). Since neither of these requirements is met by the claim, the method is not considered a patent eligible process under 35 U.S.C. 101. To qualify as a statutory process, the claim should positively recite the other statutory class to which it is tied, for example by identifying the apparatus that accomplished the method steps or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

A mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. In addition, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such as data gathering or outputting, is not sufficient to pass the test. See *In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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Claims 76-96 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lawlor et al. (US 5220501) in view of Adams (US 5177342).

Claims 76-96 are rejected under 35 U.S.C. 102(e) as being anticipated by Lawlor et al. (US 5, 220, 501).

Specifically as to claim 76, Lawlor et al. disclose a method comprising: receiving, at a payment service provider, a request to pay a payee on behalf of a payer(see abstract, figures 12, 14a-14d); selecting a form for crediting the payee based on at least one of (i) comparing a payer account number associated with the payer and the payee to a merchant account scheme associated with the payee; or (ii) comparing a payment amount associated with the received request to a merchant credit limit associated with the payee(col. 19 lines 9-11, col. 23 lines 34-38, col. 49 lines 7-28); and directing a payment to the payee in accordance with the selected form for crediting(col. 20 lines 59-67, col. 33 lines 3-60 particularly lines 15-16 and 55-57).

Specifically as to claim 86, Lawlor et al. disclose a system, comprising: an interface to a network configured to receive a request to make a payment to a payee on behalf of a payer(see abstract, figures 12, 14a-14d); and a processor configured (i) to select a form for crediting the payee based on at least one of (1) a comparison of a payer account number associated with the payer and the payee to a merchant account scheme associated with the payee, or (2) a comparison of a payment amount associated with the received request to a merchant credit limit associated with the payee (col. 19 lines 9-11, col. 23 lines 34-38, col. 49 lines 7-28), and (ii) to direct issuance of a payment to the

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payee in accordance with the selected form for crediting(col. 20 lines 59-67, col. 33 lines 3-60 particularly lines 15-16 and 55-57).

Specifically as to claim 96, Lawlor et al. disclose a system comprising: means for receiving, at a payment service provider, a request to pay a payee on behalf of a payer(see abstract, figures 12, 14a-14d); means for selecting a form for crediting the payee based on at least one of (i) comparing a payer account number associated with the payer and the payee to a merchant account scheme associated with the payee; or (ii) comparing a payment amount associated with the received request to a merchant credit limit associated with the payee (col. 19 lines 9-11, col. 23 lines 34-38, col. 49 lines 7-28); and means for directing a payment to the payee in accordance with the selected form for crediting(col. 20 lines 59-67, col. 33 lines 3-60 particularly lines 15-16 and 55-57).

Specifically as to claims 77 and 87, wherein the form for crediting comprises at least one of (i) a check payable to the payee and written on an account of the payment service provider, (ii) an electronic credit, and (iii) a paper draft payable to the payee and written on an account of the payer (column 33, line 63 - column 34, line 4).

Specifically as to claims 78 and 88, wherein the selected form for crediting is a check written on an account of the payment service provider, and wherein the check is a consolidated check (column 33, line 63 - column 34, line 4).

Specifically as to claims 79 and 89, wherein the request is a first request and the payer is a first payer, and further comprising: receiving a second request to pay the payee on behalf of a second payer; and selecting a check written on an account of the payment service provider as the form for crediting the payee on behalf of the second payer;

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wherein the consolidated check combines payment of the first request and payment of the second request (col. 20 lines 59-67, col. 33 lines 3-60 particularly lines 15-16 and 55-57).

Specifically as to claims 80 and 90, further comprising: transmitting a remittance list associated with the consolidated check to the payee (col. 20 lines 59-67, col. 33 lines 3-60 particularly lines 15-16 and 55-57).

Specifically as to claims 81 and 91, wherein the electronic credit comprises at least one of (i) an Automated Clearing House (ACH) credit and (ii) a remittance processing system credit (see also col. 42 line 60 to col. 43 line 68, col. 49 lines 7-40).

Specifically as to claims 82 and 92, wherein the selected form for crediting is a paper draft, and the paper draft comprises posting information for the payee (see also col. 42 line 60 to col. 43 line 68, col. 49 lines 7-40).

Specifically as to claims 83 and 93, wherein selecting the form for crediting the payee is further based at least in part on an examination of a settlement code associated with the payee (col. 49 lines 20-28).

Specifically as to claims 84 and 94, comparing the payment amount associated with the received request to a merchant credit limit associated with the payee, and further comprising: selecting an electronic credit as the form for crediting the payee if the payment amount is less than or equal to the merchant credit limit (col. 49 lines 20-28).

Specifically as to claims 85 and 95, comparing the payer account number associated with the payee to a merchant account scheme associated with the payee, and further comprising: selecting a paper draft as the form for crediting the payee if the payer account number with the payee fails to correspond to the merchant account scheme (col. 20 lines 59-67, col. 33 lines 3-60 particularly lines 15-16 and 55-57).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(c), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 76-96 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lawlor et al. (US 5220501) in view of Adams (US 5177342).

Specifically as to claim 76, Lawlor et al. disclose a method comprising: receiving, at a payment service provider, a request to pay a payee on behalf of a payer(see abstract,



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figures 12, 14a-14d); selecting a form for crediting the payee based on at least one of (i) comparing a payer account number associated with the payer and the payee to a merchant account scheme associated with the payee (col. 19 lines 9-11, col. 23 lines 34-38, col. 49 lines 7-28); and directing a payment to the payee in accordance with the selected form for crediting(col. 20 lines 59-67, col. 33 lines 3-60 particularly lines 15-16 and 55-57) but does not specifically disclose comparing a payment amount associated with the received request to a merchant credit limit associated with the payee.

Adams discloses a transaction approval system in which an issuer or a central processor determines if a particular transaction can be approved (column 4, lines 50-61). In order to authorize a transaction at a local terminal, the terminal determines if the account number is in an allowable format (column 5, lines 3-9).

It would have been obvious to one of ordinary skill in the art to include in the financial system of Lawlor et al. the ability to compare a payment amount associated with the received request to a merchant credit limit associated with the as taught by Adams since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Specifically as to claim 86, Lawlor et al. disclose a system, comprising: an interface to a network configured to receive a request to make a payment to a payee on behalf of a payer(see abstract, figures 12, 14a-14d); and a processor configured (i) to select a form for crediting the payee based on at least one of (1) a comparison of a payer account number associated with the payer and the payee to a merchant account scheme

associated with the payee, (col. 19 lines 9-11, col. 23 lines 34-38, col. 49 lines 7-28), and (ii) to direct issuance of a payment to the payee in accordance with the selected form for crediting(col. 20 lines 59-67, col. 33 lines 3-60 particularly lines 15-16 and 55-57) but does not specifically disclose the option of a comparison of a payment amount associated with the received request to a merchant credit limit associated with the payee.

Adams discloses a transaction approval system in which an issuer or a central processor determines if a particular transaction can be approved (column 4, lines 50-61). In order to authorize a transaction at a local terminal, the terminal determines if the account number is in an allowable format (column 5, lines 3-9).

It would have been obvious to one of ordinary skill in the art to include in the financial system of Lawlor et al. the ability to compare a payment amount associated with the received request to a merchant credit limit associated with the as taught by Adams since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Specifically as to claim 96, Lawlor et al. disclose a system comprising: means for receiving, at a payment service provider, a request to pay a payee on behalf of a payer(see abstract, figures 12, 14a-14d); means for selecting a form for crediting the payee based on at least one of (i) comparing a payer account number associated with the payer and the payee to a merchant account scheme associated with the payee; (col. 19 lines 9-11, col. 23 lines 34-38, col. 49 lines 7-28); and means for directing a payment to the payee in accordance with the selected form for crediting(col. 20 lines 59-67, col. 33 lines 3-60

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particularly lines 15-16 and 55-57) but does not specifically disclose the option of comparing a payment amount associated with the received request to a merchant credit limit associated with the payee.

Adams discloses a transaction approval system in which an issuer or a central processor determines if a particular transaction can be approved (column 4, lines 50-61). In order to authorize a transaction at a local terminal, the terminal determines if the account number is in an allowable format (column 5, lines 3-9). It would have been obvious to one of ordinary skill in the art to include in the financial system of Lawlor et al. the ability to compare a payment amount associated with the received request to a merchant credit limit associated with the as taught by Adams since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Specifically as to claims 77 and 87, wherein the form for crediting comprises at least one of (i) a check payable to the payee and written on an account of the payment service provider, (ii) an electronic credit, and (iii) a paper draft payable to the payee and written on an account of the payer (column 33, line 63 - column 34, line 4).

Specifically as to claims 78 and 88, wherein the selected form for crediting is a check written on an account of the payment service provider, and wherein the check is a consolidated check (column 33, line 63 - column 34, line 4).

Specifically as to claims 79 and 89, wherein the request is a first request and the payer is a first payer, and further comprising: receiving a second request to pay the payee

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on behalf of a second payer; and selecting a check written on an account of the payment service provider as the form for crediting the payee on behalf of the second payer; wherein the consolidated check combines payment of the first request and payment of the second request (col. 20 lines 59-67, col. 33 lines 3-60 particularly lines 15-16 and 55-57).

Specifically as to claims 80 and 90, further comprising: transmitting a remittance list associated with the consolidated check to the payee (col. 20 lines 59-67, col. 33 lines 3-60 particularly lines 15-16 and 55-57).

Specifically as to claims 81 and 91, wherein the electronic credit comprises at least one of (i) an Automated Clearing House (ACH) credit and (ii) a remittance processing system credit (see also col. 42 line 60 to col. 43 line 68, col. 49 lines 7-40).

Specifically as to claims 82 and 92, wherein the selected form for crediting is a paper draft, and the paper draft comprises posting information for the payee (see also col. 42 line 60 to col. 43 line 68, col. 49 lines 7-40).

Specifically as to claims 83 and 93, wherein selecting the form for crediting the payee is further based at least in part on an examination of a settlement code associated with the payee (col. 49 lines 20-28).

Specifically as to claims 84 and 94, comparing the payment amount associated with the received request to a merchant credit limit associated with the payee, and further comprising: selecting an electronic credit as the form for crediting the payee if the payment amount is less than or equal to the merchant credit limit (col. 49 lines 20-28).

Specifically as to claims 85 and 95, comparing the payer account number associated with the payee to a merchant account scheme associated with the payee, and further comprising: selecting a paper draft as the form for crediting the payee if the payer

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account number with the payee fails to correspond to the merchant account scheme (col. 20 lines 59-67, col. 33 lines 3-60 particularly lines 15-16 and 55-57).

### ***Examiner's Note***

Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

### ***Response to Arguments***

Applicant's arguments filed 3/13/2008 have been fully considered but they are not persuasive.

While applicant's arguments are directed to the limitation of "comparing a payment amount associated with the received request to a merchant credit limit associated with a payee", applicant is reminded that this limitation is included in the claim within an "or" statement and is therefore not a required limitation in the claim, as such, the argument is moot.

In the event the application wishes to argue this limitation, the above new grounds of rejection have been presented as a 35 USC 102/103 rejection.

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With regards to the double patenting rejection, the rejection has been overcome and hence withdrawn with the filing of a terminal disclaimer.

The amendments to the Abstract have overcome the Objections and as such are withdrawn.

The amendments and arguments to the 35 USC 112 rejection have overcome the rejection and as such it is withdrawn.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KELLY CAMPEN whose telephone number is (571)272-6740. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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